

### **REMARKS/ARGUMENTS**

Claims 1-5, 8-11, 30-32, 35-38 are now pending in this application. Claims 1 and 30 are independent claims. Claim 1 has been amended. Claims 6, 7, 33 and 34 have been cancelled.

#### ***Drawings***

The drawings were objected to under 37 CFR 1.83(a). (Office Action, Page 2). Specifically, the Patent Office contends that the drawings fail to show the following claimed features: a universal adapter assembly and a pick-off pivot assembly. (Office Action, Page 2). The terms universal adapter assembly and pick-off pivot assembly have been cancelled from the claims to address the rejections under this section.

#### ***Claim Rejections – 35 USC § 112***

Claim 7 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office Action, Page 3). Specifically, the Patent Office contended that it was not clear what was meant by a pick-off pivot assembly. Claim 7 has been cancelled to address the rejections under this section.

#### ***Claim Rejections – 35 USC § 102***

Claims 1-4, 11, 30-32 and 38 were rejected under 35 U.S.C. § 102(a) as being anticipated by Shkolnikov USPN: 6,739,490 (hereinafter: Shkolnikov). Applicants respectfully traverse these rejections.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, “anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983))

(emphasis added).

Independent claim 1 includes elements that have not been disclosed, taught or suggested by Shkolnikov. For example, claim 1 recites:

“wherein the pivoting probe assembly hinders the nail from advancing when the nail engages with the pivoting probe assembly in an incorrect position, the pivoting probe assembly locking in position, thereby preventing further advancement of the nail within the nail gun.”

Applicants contend that Shkolnikov does not teach the above-referenced elements.

In the present invention, the nail checker assembly includes a pivoting probe assembly for engaging a nail advancing within a nail loading assembly. (Present Application, Page 3, Paragraph 0006). Through engagement of the nail with the pivoting probe assembly, the nail checker assembly determines the positioning of the advancing nail. (Present Application, Page 4, Paragraph 0007). If the nail is correctly positioned, then the nail is allowed to advance to the nail driving assembly. (Present Application, Page 4, Paragraph 0007). If the nail is incorrectly positioned, the nail's advancement is hindered. (Present Application, Page 15, Paragraph 0028). For example, if the nail is part of a collated nail strip, the collated nail strip is locked into place within the nail gun by the nail checker assembly. (Present Application, Page 17, Paragraph 0032). When the nail strip locks in place, this provides the operator of the nail gun an indication that the nails selected are incorrect for use with the nail gun. (Present Application, Page 17, Paragraph 0032).

In Shkolnikov, a pivoting lever, which the Patent Office contends is equivalent to a pivoting probe assembly, is established at the bottom of the magazine so that fasteners (i.e.-nails) advancing within the magazine which are shorter than a pre-determined length (i.e.-are correctly positioned) will pass above the pivoting lever without contacting (i.e.-engaging) it as they move through the magazine and toward the nail driving assembly. The pre-determined length is the maximum ideal length for a fastener to be utilized with the Shkolnikov nail gun. Long fasteners exceed the pre-determined length (i.e.-are incorrectly positioned) and displace the pivoting lever as they advance within the magazine towards the nail driving assembly, thereby causing the lever to pivot and

contact a sensor. The sensor then sends a signal which causes the nail gun to vary its power output in order to provide sufficient power to drive the long fastener, since the long fastener exceeds the ideal pre-determined length for a fastener to be used with the Shkolnikov gun. (Shkolnikov, Column 5, Lines 11-67).

In the present invention, if a nail advancing within the magazine engages with the pivoting probe assembly in an incorrect position, the nail's advancement is hindered. (Present Application, Page 17, Paragraph 0032). Further, the pivoting probe assembly locks in position, thereby preventing further advancement of the nail within the nail gun. (Present Application, Page 17, Paragraph 0032). Therefore, the incorrectly positioned nail will not advance through the magazine to the nail driving assembly. (Present Application, Pages 16-17, Paragraph 0032). This element of the present invention is advantageous in that it assists in preventing misfires which can cause damage to the nail gun. (Present Application, Page 6, Paragraph 0013). In Shkolnikov, correctly positioned nails (i.e.-nails of less than a pre-determined height) advance through the magazine *without* having to engage with the pivoting lever (which Patent Office contends is equivalent to a pivoting probe assembly) at all. (Shkolnikov, Column 5, Lines 51-53). Further, no mention is made in Shkolnikov of any nails (either correctly or incorrectly positioned) being hindered by the pivoting lever from advancing to the nail driving assembly. The pivoting lever in Shkolnikov serves a different purpose, it detects if an incorrectly positioned nail (i.e.- a nail longer than a pre-determined length) is being used and, instead of preventing the incorrectly positioned nail from advancing, it triggers a chain of events which cause the nail gun to accommodate the incorrectly positioned nail by varying its power level to meet the increased power demands of driving the longer nail. (Shkolnikov, Column 5, Lines 11-67 and Column 6, Lines 22-59). The pivoting lever in Shkolnikov does not *require* that each nail engage with the pivoting lever in a correct position in order to be driven by the nail gun. (Shkolnikov, Column 5, Lines 11-67 and Column 6, Lines 22-59). In Shkolnikov, nails within the pre-determined height range (correctly positioned) pass above and do not engage with the pivoting lever on their way to the nail driving assembly. (Shkolnikov, Column 5, Lines 51-53). Also in Shkolnikov, longer nails exceeding the pre-determined height (i.e.- incorrectly positioned

nails), engage with the pivoting level and are still allowed to pass on to the nail driving assembly. (Shkolnikov, Column 5, Lines 54-61). Although the longer nails engage with the pivoting lever and are incorrectly positioned, they are not hindered or prevented from advancing to the nail driving assembly, a longer nail merely triggers a signal to the nail gun to vary its power so that the longer nail may be driven after it reaches the nail driving assembly. Therefore, applicants contend that Shkolnikov does not teach the above-referenced elements of claim 1.

Independent claim 30 includes elements that have not been disclosed, taught or suggested by Shkolnikov. For example, claim 30 recites:

“means for hindering the nail from advancing if the positioning of the advancing nail is incorrect”

Again, the Patent Office makes no specific reference to Shkolnikov teaching the above-referenced elements. Further, applicants contend that Shkolnikov does not teach the above-referenced elements. In the present invention, each nail engages the pivoting probe assembly. If the positioning of the advancing nail is incorrect, the nail is hindered from advancement via the pivoting probe assembly's contact with the lock ledge assembly and will *not* advance to the nail driving assembly. (Present Application, Pages 11 and 12, Paragraph 0024). Shkolnikov makes no reference to a means for hindering a nail from advancing if the positioning of the advancing nail is incorrect. In Shkolnikov, an advancing nail that exceeds a pre-determined height (long nail) is incorrectly positioned and will engage with the pivoting lever, thereby causing the pivoting lever to rotate and contact a sensor, the sensor then sends a signal to the nail gun to vary the power to a level sufficient to drive the long nail. At no point, however, does Shkolnikov mention that the long nail, nor any nail, is hindered in advancing to the nail driving assembly.

Based on the above rationale, it is contended that Shkolnikov does not teach the above-referenced elements of independent claims 1 and 30 of the present application. Under *Lindemann*, a *prima facie* case of anticipation has not been established for claims 1 and 30. Thus, independent claims 1 and 30 should be allowed. Dependent claims 2, 3, 4 and 11 (which depend on independent claim 1) and dependent claims 31, 32 and 38

(which depend on independent claim 30) should also be allowed.

***Claim Rejections – 35 USC § 103***

Claims 5-8, 10, 33-35 and 37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shkolnikov in view of Chen USPN: 6,431,428 (hereinafter: Chen). Claims 9 and 36 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shkolnikov in view of Wohlwend et al. USPN: 6,685,078 (hereinafter: Wohlwend). Claims 6, 7, 33 and 34 have been cancelled. It is contended that all of the pending claims rejected under this section depend on either independent claim 1 or independent claim 30, both of which are non-anticipatory and non-obvious based on the rationale above. Thus, dependent claims 5 and 8-10 (which depend on independent claim 1) and dependent claims 35-37 (which depend on independent claim 30) should be allowed.

**CONCLUSION**

In light of the forgoing, reconsideration and allowance of the pending claims is earnestly solicited.

Respectfully submitted on behalf of  
Porter-Cable Corporation,

By: 

Jeffrey M. Andersen  
Reg. No. 52,558

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Jeffrey M. Andersen  
SUITER • WEST PC LLO  
14301 FNB Parkway, Suite 220  
Omaha, NE 68154  
(402) 496-0300      telephone  
(402) 496-0333      facsimile